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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATTTI SALMI, DOGU CETIN, MISKA HANNUKSELA,
ROBERTO CASTAGNO, and MIKA RANTANEN

Appeal 2009-000912
Application 09/761,040
Technology Center 2400

Decided: December 14, 2009

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and JEAN R.
HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-26. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal relates to "[a] method for presenting information contained in messages in a multi-media terminal, a system for transmitting multimedia messages, and a multimedia terminal." (Spec. 1.)

ILLUSTRATIVE CLAIM

1. A method for presenting information contained in user messages transmitted to a multimedia terminal in a multimedia messaging system in a user interface of the multimedia terminal, in which method the user message comprises address data indicative of a recipient of the user message and at least one multimedia component, wherein in the method, a presentation model is formed to contain information related to at least one multimedia component included in the user message, said presentation model is supplemented with a reference to the location of data in said user message related to presenting said at least one multimedia component included in said user message, said last recited user message being the same user message as said first recited user message, said presentation model is added to said same user message.¹

PRIOR ART

Jaisimha

US 6,487,663 B1

Nov. 26, 2002

¹ "Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation." 37 C.F.R. § 1.75(i). Here, the lack of separation of the elements and steps obfuscates the claim.

REJECTION

Claims 1-26 stand rejected under 35 U.S.C. § 102(e) as anticipated by Jaisimha.

ISSUE

The issue before us is whether claims 1-26 are indefinite and thus prevent us from reaching the rejection for anticipation.

LAW

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. "The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir. 1991)). For example, a claim is indefinite "where the language 'said lever' appears in a dependent claim where no such 'lever' has been previously recited" *Ex parte Moelands*, 3 USPQ2d 1474, 1476 (BPAI 1987). Furthermore, "[t]he drawing in a nonprovisional application must show every feature of the invention specified in the claims." 37 C.F.R. § 1.83(a).

A rejection should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim,

the subject matter does not become obvious—the claim becomes indefinite."

In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

FINDINGS OF FACT (FFs)

1. Independent claim 1 recites the following limitations:

1. A method for presenting information contained in user messages transmitted to a multimedia terminal in a multimedia messaging system in a user interface of the multimedia terminal, in which method *the user message* comprises address data indicative of a recipient of the user message and at least one multimedia component, wherein in the method, a presentation model is formed to contain information related to at least one multimedia component included in the user message, said presentation model is supplemented with *a reference to the location of data in said user message* related to presenting said at least one multimedia component included in said user message, *said last recited user message being the same user message as said first recited user message*, said presentation model is added to *said same user message*.

(Emphases added.)

2. Claim 1 recites in pertinent part the following limitations:

the user message comprises address data indicative of a recipient of the user message and *at least one multimedia component*, wherein in the method, a presentation model is formed to contain information related to *at least one multimedia component* included in the user message, said presentation model is supplemented with a reference to the location of data in said user message related to presenting *said at least one multimedia component* included in said user message

(Emphases added.)

3. The same claim recites in pertinent part the following limitations:
"said last recited user message being the same user message as said first
recited user message."

4. The Appellants' Figure 6b follows.

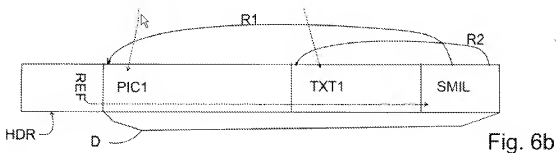


Figure 6b "shows the rough structure of a multimedia message formed by
the method according to a preferred embodiment of the invention"
(Spec. 5.)

5. The Appellants' Figure 6c follows.

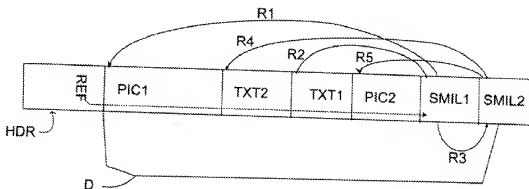


Fig. 6c

Figure 6c "shows another rough structure of a multimedia message formed by the method according to a preferred embodiment of the invention."
(Spec. 5.)

6. Claim 22 recites in pertinent part the following limitations:

22. A receiving multimedia terminal which comprises:

a receiver configured to receive *user messages*,

a user interface configured to present information contained in the user messages, wherein *each user message* comprises address data indicative of a recipient of the user message and at least one multimedia component,

an interpretation block configured to interpret a presentation model attached in *a user message* . . .

(Emphases added.)

ANALYSIS

Claim 1 (FF 1), claim 21, and claim 26 recite "*the* user message," "*said* last recited user message," "*said* first recited user message," "*the* same user message," and "*said* same user message." The three claims fail, however, to previously recite "*a* user message," "*a* last recited user message," "*a* first recited user message," or "*a* same user message."

Similarly, claim 12 and claim 22 recite "*said* last recited user message," "*said* first recited user message," "*the* same user message," and "*said* same user message." The two claims fail, however, to previously recite "*a* last recited user message," "*a* first recited user message," or "*a* same user message."

Claim 1 (FF 2) and claim 21 twice recite "at least one multimedia component." The two claims fail, however, to reasonably apprise those of skill in the art of the relation between the two recitations. For example, it is uncertain whether these recitations refer to the same multimedia component or different multimedia components. If these refer to the same component, the relation could be clarified by adding the qualifier "said" to the second recitation.

Furthermore, claim 1 (FF 2) and claim 21 recite "*said* at least one multimedia component." The two claims fail, however, to reasonably apprise those of skill in the art to which, if either, of the two previously recited instances of "at least one multimedia component" the qualifier "said" in "*said* at least one multimedia component" refers.

Claim 1 (FF 3), claim 12, claim 21, and claim 22 also recite "said last recited user message being the same user message as said first recited user message." The four claims fail, however, to reasonably apprise those of skill in the art of what it means for the last recited message to be the same as the first recited message. The Appellants' *Summary of Claimed Subject Matter* cites to "Figs. 6b and 6c" (Appeal Br. 8) in an attempt to clarify the limitations. Each of these Figures, however, shows only a single message. (FF 4 and 5.) Furthermore, the message shown in Figures 6b and the message shown in Figure 6c appear to be different messages (rather than the same message.)

Also, claim 22 recites "a receiver configured to receive *user messages*," "*each user message* comprises address data indicative of a recipient of the user message and at least one multimedia component," [and] an interpretation block configured to interpret a presentation model attached in *a user message . . .*" (FF 6.) The claim fails, however, to reasonably apprise those of skill in the art of the relation, if any, between "a user message" and the previously recited "user messages" and "each user message."

Claim 1 (FF 1), claim 12, claim 21, and claim 22 also recite "said presentation model is supplemented with a reference to the location of data in said user message." Claim 26 recites similar limitations. Figures 6b and 6c show "SMIL" fields. (FFs 4 and 5.) Because none of the Appellants' figures shows the content of the SMIL fields, however, it is unclear that the Appellants have depicted the "reference to the location of data in said user message." Furthermore, the Appellants' *Summary of Claimed Subject Matter* does not explain where this limitation is depicted.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that claims 1-26 are indefinite. Therefore, we reject claims 1-26 under 35 U.S.C. § 112, ¶ 2 as indefinite for failing to particularly point out and distinctly claim the Appellants' invention.

Furthermore, the indefiniteness of these claims leaves us in a quandary as to what they specify. Speculations and assumptions would be

required to decide the meaning of the terms employed therein and the scope of the claims. Therefore, we reverse *pro forma* the Examiner's rejection of these claims.

We emphasize that our reversal is based on procedure rather than on the merits of the obviousness rejections. The reversal does not mean that we consider the claims to be patentable under 35 U.S.C. § 102(e) as presently drawn.

DECISION

We reverse the rejection of claims 1-26 and enter a new rejection against the same claims.

37 C.F.R. § 41.50(b) provides that "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED

37 C.F.R. § 41.50(b)

rwk

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